

### REMARKS

This paper responds to the *Office Action* dated November 5, 2009. Claims 1, 16-17, 21-22, and 24 are amended. Claim 5 is canceled. No claims are added. Consequently, claims 1-4, 6, 9-13, and 16-25 are now pending in this application.

#### The Rejection of Claims Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-6, 9-10, 13, 16-18 and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,139,983 B2 to *Kelts* in view of U.S. Patent Publication No. 2003/0028889 A1 to *McCoskey*.<sup>1</sup>

#### *1. The Applicable Law*

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence.<sup>2</sup> The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*<sup>3</sup>: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

*KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known*** in the prior art and one skilled in the art could have combined the elements as claimed by known methods ***with no change in their respective functions, and the combination would have yielded nothing more than predictable results*** to one of ordinary skill in the art.<sup>4</sup>

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<sup>1</sup> *Office Action* at 2.

<sup>2</sup> See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005).

<sup>3</sup> 383 U.S. 1, 17 (1966).

<sup>4</sup> See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

## 2. *Application of § 103 to the Rejected Claims*

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all elements of Applicants' claimed elements, with no change in the respective functions of the cited references, nor is there any substantiating evidence that any combination of the references would have yielded predictable results. "If any of these [three] findings cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."<sup>5</sup>

Although other rationales for rejection under 35 U.S.C. §103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim against the prior art."<sup>6</sup> Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.<sup>7</sup>

Applicants have amended each of independent claims 1, 16-17, 21-22, and 24 to recite, in part, the language of original claim 5, which Applicants have hereby canceled. Thus, each of independent claims 1, 16-17, 21-22, and 24 now recites, in part,

[W]herein a first content provider identifier has an associated link that links the content destination to a first content provider upon selection of the first content provider identifier, the first content provider providing the at least one available content identifier to the content destination for display on a display device.

In support of the assertion that *Kelts* discloses this limitation, the Examiner cited *Kelts* at col. 10, lines 27-32 and Fig. 1.<sup>8</sup> *Kelts* is directed to "[a] navigation interface display system [that] generates a navigation element that organizes television programming data in an easy-to-use manner."<sup>9</sup> To that end, the portion of *Kelts* that the Examiner cited states

The user can highlight a particular selection item and select that item to view the corresponding program. For example, FIG. 1

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<sup>5</sup> MPEP § 2143, emphasis added.

<sup>6</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

<sup>7</sup> See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaecq*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

<sup>8</sup> *Office Action* at 5.

<sup>9</sup> *Kelts* at Abstract.

depicts selection item 116 (for the BRAVO channel) in a highlighted mode; the user may press the "select" or "enter" button to view this channel, press the "display" button to view the schedule box corresponding to this channel, or press the "context" button to view information related to the current program on this channel.

Thus, *Kelts* discusses providing a user with a navigation interface display for viewing a channel or viewing information related to a current program on the channel. However, *Kelts* neither discloses that an item that the user selects "has an associated link that links the content destination to a first content provider" nor that "upon selection" of the item, the "content provider provide[s] the at least one available content identifier to the content destination," as recited in each of independent claims 1, 16-17, 21-22, and 24. To the contrary, *Kelts* discusses that navigation links are associated with databases that are part of the navigation system. *See*, e.g., col. 37, lines 47-50 ("[a] task 1606 is performed to retrieve the interface data (from the interface databases) associated with the requested navigation element." Additionally, although *Kelts* mentions that "content providers and service providers will be responsible for updating and maintaining the data stored in application databases 606,"<sup>10</sup> *Kelts* specifies that the databases will be centrally maintained by service providers.

Although not a requirement of the display system, process 1600 is described herein in the context of a deployment to support one system administrator, e.g., one broadcast service provider such as a cable television company. In other words, although one display system may be deployed in a manner that supports a plurality of service providers, a realistic practical implementation will enable one service provider to support its subscribers in a centralized manner.<sup>11</sup>

In other words, *Kelts* merely specifies that navigation elements selected by the user are associated with content in *a database that is maintained centrally by a service provider*, which is contrary to, at least, the limitation recited above that Applicants have included into each of amended independent claims 1, 16-17, 21-22, and 24, that specifies that "upon selection of [a] first content provider identifier," "a first *content provider*" itself "provid[es] the at least one available content identifier to the content destination" (emphasis added).

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<sup>10</sup> *Id.* at col. 19, lines 52-54.

<sup>11</sup> *Id.* at col. 37, lines 19-26.

The Examiner cited *McCoskey* for the assertion that *McCoskey* discloses various other elements of the independent claims that *Kelts* does not disclose.<sup>12</sup> *McCoskey* is directed to “[a] system for searching, packaging and delivering content using an aggregator.”<sup>13</sup> To that end, *McCoskey* states

*The aggregator processes requests, searches, provides search results and acquires content. The aggregator, operating in a communications network, includes a request and results processing server and a content acquisition server coupled to the request and results processing server. A request and results processing server receives a request for content, the search engine server searches for the content and the content acquisition program acquires content for delivery to the user. The request and results processing server includes a search request processor that receives information related to a user's search request and provides the information to a search results form builder that creates an electronic search request. The search request may be augmented by using a content suggestion engine to add additional search terms and descriptions to the search request. The aggregator may also include a decoder that decodes program content and program metadata from remote sources for storage at the aggregator, and an encoder that encodes content metadata and programs for delivery to the user. The aggregator may also comprise one or more crawlers, such as a content crawler, to look for program content in one or more digital communications networks.*<sup>14</sup>

In addition, *McCoskey* states

FIG. 2 also shows a communications path from one or more remote content servers 204 through the wide area network/Internet 205 directly to the set top terminal 206, which bypasses the aggregator 201 and cable television system headend 210. *This path may be used in the case where the requested content is available in the required format from the remote content server 204 and is authorized for direct delivery to the user.* In an alternative embodiment, the aggregator 201 is collocated with the cable television system headend 210 that is acting as the wide area distribution system 203 as is the case when a cable television system is also serving as the user's Internet service provider.<sup>15</sup>

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<sup>12</sup> *Office Action* at 4, 7-10.

<sup>13</sup> *McCoskey* at Abstract.

<sup>14</sup> *Id* (emphasis added).

<sup>15</sup> *Id.* at [0046] (emphasis added).

Thus, *McCoskey* shows that the aggregator, which is separate from the remote content servers,<sup>16</sup> is only bypassed “in the case where the requested content is available in the required format from the remote content server 204 and is authorized for direct delivery to the user.”<sup>17</sup> . In fact, *McCoskey*, like *Kelts*, does not disclose that a *content provider* itself is linked in any way to a “first content provider identifier” such that, for example, the *content provider* provides, “upon selection of the first content provider identifier,” “at least one available content identifier to the content destination,” as recited in each of independent claims 1, 16-17, 21-22, and 24 (emphasis added). To the contrary, *McCoskey* discusses that *an aggregator*, separate from the remote content provider, receives user requests for content and performs searches to find the content. *McCoskey* states that the aggregator is bypassed in specific circumstances during a delivery of content that the aggregator previously found in response to a user query; however, *McCoskey* does not disclose that the aggregator is bypassed such that the *content provider* may provide information about available content to the content destination. Instead, *McCoskey* suggests that *the aggregator* handles all user requests for available content using, for example, its Internet searching and crawling capabilities.

The Examiner also rejected claims 11, 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Kelts* in view *McCoskey* and in further view of U.S. Patent No. 6,184,878 B1 to *Alonso*. However *Alonso* does not disclose at least the above limitations of the independent claims that *Kelts* and *McCoskey* do not disclose.

Because Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Kelts* singly or by *Kelts* in any combination with *McCoskey* or *Alonso*, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103 with regard to independent claims 1, 16-17, 21-22, and 24. In addition, any claim depending from a non-obvious independent claim is also non-obvious for at least the same

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<sup>16</sup> See, e.g., FIGs. 1-5. See also, e.g., paragraph [0034] (“Other components are remote content servers 204 that exchange data with the aggregator 201 using a wide area network/Internet 205 connection.”)

<sup>17</sup> *Id.*

reasons as the claims from which they depend.<sup>18</sup> Therefore, Applicants respectfully request that the Examiner also withdraw the rejection of claims 2-4, 6, 9-13, 18-20, 23, and 25 under 35 U.S.C. § 103(a). Furthermore, each of the dependent claims may be patentable for its own limitations.

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<sup>18</sup> See MPEP § 2143.03.

**CONCLUSION**


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 660-2016 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5<sup>th</sup> day of February, 2010.

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